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EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

400812

Applicant(s)

McELFRESH

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 4, 6, 7, 9, 18 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 4, 6, 7, 9, 18 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1712

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/02 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 4, 7, 9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants teaching of R' as being hydrogen in the formula is not supported by the specification, and adds new matter. Applicants specification only taught

Art Unit: 1712

one compound TAPAO which included R' as hydrogen, which cannot be extrapolated to the several other possible compounds within the scope of formula (I).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 depends from cancelled claim 17.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Art Unit: 1712

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1, 4, 7, 9 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 99/32572.

WO '572 teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (see page 11, line 18 to page 12, line 9). Various other stimulating agents, such as alcohols, hydrocarbons, anti-freeze agents, anti-foamants and lubricants, which are inclusive of acidic agents, may be added to the fluid (pages 10-11). The fluids may contain various salts and cellulose materials which would act as fluid loss agents (page 6, lines 1-9). The present invention is thus anticipated by WO '572.

8. Claims 1, 4, 7, 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Farmer (6239183).

Farmer teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (column 7, lines 12-30). Various other stimulating agents, such as alcohols, hydrocarbons, anti-freeze agents, anti-

Art Unit: 1712

foamants and lubricants, which are inclusive of acidic agents, may be added to the fluid (column 6, lines 18-43 and column 7, lines 36-41). The fluids may contain various salts and cellulose materials which would act as fluid loss agents (column 2, line 64 - column 3, line 7). The present invention is thus anticipated by Farmer.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/32572.

WO '572 teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (see page 11, line 18 to page 12, line 9). Various other stimulating agents, such as alcohols, hydrocarbons, anti-freeze agents, anti-foamants and lubricants, which are inclusive of acidic agents, may be added to the fluid (pages 10-11). The fluids may contain various salts and cellulose materials which would

Art Unit: 1712

act as fluid loss agents (page 6, lines 1-9). WO '572 differs from the present invention in not specifically teaching the use of tallow amido propyl amine oxide as an amine oxide useful in the invention. WO '572 however teaches the use of Tallow amido propyl dimethylamine oxide in the drilling and treating fluids (example 8). As homologues and analogues with such similar structures would be expected to have similar properties and utility, it would be obvious to one of ordinary skill in the art to utilize various homologues and analogues of the amine oxides disclosed by WO '572, including the tallow amido propyl amine oxide of the present invention, since such homologues and analogues would be expected to be useful in the viscoelastic well fluids of WO '572 (Ex parte Faque 121 USPQ 425).

11. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer (6239183).

Farmer teaches viscoelastic fluids which comprise a nonionic amine oxide which are used in areas such as for drilling fluids and fracturing fluids, wherein the amine oxide is the only gelling agent (see example 8). Proppants and breakers may be added (column 7, lines 12-30). Various other stimulating agents, such as alcohols, hydrocarbons, anti-freeze agents, anti-foamants and lubricants, which are inclusive of acidic agents, may be added to the fluid (column 6, lines 18-43 and column 7, lines 36-41). The fluids may contain various salts and cellulose materials which would act as fluid loss agents (column 2, line 64 - column 3, line 7). The present

Art Unit: 1712


invention is thus anticipated by Farmer. Farmer differs from the present invention in not specifically teaching the use of tallow amido propyl amine oxide as an amine oxide useful in the invention. Farmer however teaches the use of Tallow amido propyl dimethylamine oxide in the drilling and treating fluids (example 8). As homologues and analogues with such similar structures would be expected to have similar properties and utility, it would be obvious to one of ordinary skill in the art to utilize various homologues and analogues of the amine oxides disclosed by Farmer, including the tallow amido propyl amine oxide of the present invention, since such homologues and analogues would be expected to be useful in the viscoelastic well fluids of Farmer (Ex parte Faque 121 USPQ 425).

12. Applicants arguments have been considered but are not deemed persuasive. As noted in the above rejections, the fluids taught by the WO reference contain stimulating agents, acids and fluid loss agents, and thus the present invention is not distinguished from WO '572.

Art Unit: 1712

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2809
November 2, 2000


PHILIP C. TUCKER
ART UNIT 1712